

REMARKS

This Amendment and Response is submitted in reply to the Office Action dated September 7, 2006, in which the Examiner:

rejected claims 7-19 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2001/0035215 to Tipton et al.; and

rejected claims 7-19 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application Publication No. 2004/0020474 to Pratt et al.

Applicants respectfully traverse the rejections below. Claims 7-19 are currently pending. Claim 7, directed to a fuel return device, and claim 19, directed to a fuel return method, are independent claims.

Claims 7 and 19 were rejected under 35 U.S.C. § 102(e) as anticipated by Tipton. An anticipation rejection under § 102 is improper unless a single prior art reference shows or discloses each and every claim recitation.

Applicants' claim 7 recites, in part, a fuel return device for an internal combustion engine for recovering surplus fuel supplied to the internal combustion engine simultaneously from a plurality of fuel tanks, and returning the recovered fuel to the respective fuel tanks. Applicants' claim 19 recites, in part, a fuel return method for an internal combustion engine for recovering surplus fuel supplied to the internal combustion engine simultaneously from a plurality of fuel tanks, and returning the recovered fuel to the respective fuel tanks.

Tipton does not show or disclose each and every recitation of Applicants' claims 7 or 19. For example, Tipton does not disclose a fuel return device or method for recovering surplus fuel supplied to the internal combustion engine

simultaneously from a plurality of fuel tanks. Instead, in the Tipton apparatus, fuel appears to be exclusively supplied to the engine from, and returned to, a first fuel tank 24. Second fuel tank 26 is used to supply additional fuel to the first fuel tank 24 through a transfer pump 22 and not to the engine *simultaneously* with the first fuel tank 24, and second fuel tank 26 does not appear to receive returning fuel.

Thus, Tipton does not show or disclose each and every recitation of Applicants' claims 7 or 19. Accordingly, Applicants respectfully submit that the rejection of claims 7 and 19 under 35 U.S.C. § 102(e) as anticipated by Tipton is improper for at least this reason, and should be withdrawn.

Claims 8-18 were also rejected under 35 U.S.C. § 102(e) as anticipated by Tipton. Claims 8-18 all depend, directly or indirectly, from claim 7 and include additional recitations thereto. Accordingly, Applicants respectfully submit that the rejection of claims 8-18 under 35 U.S.C. § 102(e) as anticipated by Tipton is improper for at least the reasons stated in connection with claim 7, and should be withdrawn.

Claims 7-19 were rejected under 35 U.S.C. § 102(b) as anticipated by Pratt. A publication does not qualify as prior art against an application under § 102(b) unless the publication was published more than a year before the effective U.S. filing date of the application.

The current application is the U.S. National Stage of International Application PCT/JP03/10132, filed on August 8, 2003. See MPEP 1893.03(b). Thus, the current application has an effective U.S. filing date of at least as early as August 8, 2003. Pratt was not published until February 5, 2004. Thus, Pratt does not qualify as prior art under § 102(b) against the current application.

Accordingly, Applicants respectfully submit that the rejection of claims 7-19 under 35 U.S.C. § 102(b) as anticipated by Pratt is improper, and should be withdrawn.

In the interest of furthering prosecution, Applicants note that Pratt also fails to qualify as prior art under 35 U.S.C. § 102(a), as Pratt was not published until after the effective U.S. filing date of the current application. Under § 102(e) Pratt is entitled to a prior art date, at the earliest, of its U.S. filing date of August 5, 2002.

Regarding a possible rejection under 35 U.S.C. § 102(e), Applicants respectfully submit, pursuant to 37 C.F.R. § 1.131:

1) that the subject matter of the current claims was conceived in Japan, a World Trade Organization (WTO) member country, prior to the U.S. filing date of the Pratt application (see Declarations of Takeshi Tokumaru and Takeshi Seto, paragraphs 1-4);

2) that the subject matter of the current claims was reduced to practice at least as early as August 13, 2002, on which date the priority Japanese patent application was filed (see Declarations of Takeshi Tokumaru and Takeshi Seto, paragraph 5); and

3) that the reduction to practice was diligently pursued in Japan from a date prior to the U.S. filing date of the Pratt application until the filing date of the priority Japanese patent application (see *id.*; see also Declaration of Nobuo Kinutani).

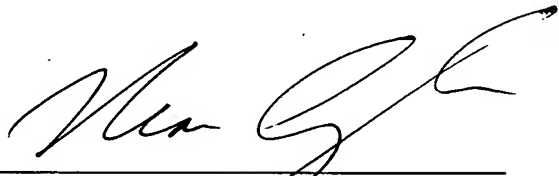
Accordingly, Applicants respectfully submit that they have effectively antedated Pratt, such that any subsequent rejection of claims 7-19 under 35 U.S.C. § 102(b) as anticipated by Pratt would be improper.

Having traversed each and every claim rejection, Applicants respectfully request that the rejection of claims 7-19 be withdrawn, and claims 7-19 be passed to issue.

Applicants respectfully submit that nothing in the current Amendment constitutes new matter. The Specification was amended to correct minor grammatical errors in the translated application. Claim 18 was amended to correct the claim dependency.

Beyond the fees already submitted for a two-month extension, Applicants believe no additional fees are due in connection with the current Amendment and Response. If any additional fees are deemed necessary, authorization is hereby granted to charge any such fees to Deposit Account No. 13-0235.

By



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